

REMARKS

Claims 1-9 are pending. Claims 1, 4 and 7 were examined. It is not clear if Claims 2, 3, 5, and 6 were examined because they were not discussed in the detailed action section of the March 7, 2006 office action. No first or second office action has been taken on Claims 8-9.

Applicant respectfully notes that claims 8-9 were present in the original specification, and have never been examined, subject to restriction, or any notice of irregularity given.

Applicant also respectfully notes that these same claims 8-9 were again submitted in the claims portion of the applicant's 12/29/2005 response to the first office action, and again neither examined, subject to restriction, or any notice of irregularity given. Applicant respectfully requests office action on the merits of claims 8-9.

Claims 1, 4 and 7 were rejected under the doctrine of obviousness type double patenting as being unpatentable over claims 1 and 4 of U.S. patent 6,658,325 B2. The basis for any rejection of claims 2, 3, 5, and 6 is unclear because these claims were not discussed in the detailed action. As previously discussed, claims 8-9 have never been examined.

Applicant respectfully traverses and overcomes the finality of the rejection on the basis that, under MPEP 706.07(a) *Final Rejection, When Proper on Second Action [R-3]*, it was premature to make this rejection final. MPEP 706.07(a) states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)...

*When applying any 35 U.S.C. 102(e)/ 103 references against the claims of an application ** the examiner should anticipate that a statement averring common ownership at the*

time the invention was made may disqualify any patent or application applied in a rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). If such a statement is filed in reply to the 35 U.S.C. 102(e)/ 103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made [emphasis added]

Applicant respectfully traverses examiner's decision to make the office action mailed 3/7/2006 final on the basis that this decision is inappropriate in view of the common-ownership exclusion criteria of MPEP 706.07(a). Specifically, the present response contains a statement averring (attesting to) common ownership of patent 6,658,325 B2 at the time the invention was made. This disqualifies the use of this patent in an obviousness-type rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). As per MPEP 706.07(a), this present response overcomes the final rejection because it contains an allowed reply to the obviousness-type 35 U.S.C. 102(e)/ 103 rejection, and the present claims have not been amended from the previous response.

Applicant also respectfully traverses the assertion that applicant's amendment necessitated the new grounds of action. Since, as mentioned above, and as will be discussed in more detail shortly, the grounds for action were based upon this inadmissible (under MPEP 706.07(a) and MPEP 804) use of applicant's own '325 prior art, applicant's amendment did not, in fact, necessitate new grounds for a final rejection. As will be discussed in more detail later in this response, there appears to be no other basis for rejection other than this inadmissible use of the '325 patent. Applicant will show grounds why the appropriate course of action should be allowance contingent upon receipt of a terminal disclaimer (provided in this response).

Applicant further traverses the finality of the 3/7/2006 office action on the basis that the grounds for rejection of claims 2, 3, 5, and 6 were not stated, and there has been no prior office action of any sort on the merits of claims 8 and 9.

To expedite prosecution, applicant will respectfully continue with the remainder of this response as if it were the response to a non-final office action.

Response to office action section 3: Double Patenting

Applicant respectfully traverses the non-statutory obviousness-type double patenting rejection on the first grounds that according to MPEP 804, the parent patent (in this case US patent 6,658,325 B2) is owned by the applicant, cannot be used as prior art in an obviousness-type double patenting rejection. According to MPEP 804:

*A double patenting rejection of the obvious-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obvious-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).*

*Since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:*

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;*
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;*
- (C) Determine the level of ordinary skill in the pertinent art; and*
- (D) Evaluate any objective indicia of nonobviousness.*

The conclusion of obvious-type double patenting is made in light of these factual determinations.

Any obvious-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and*
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.*

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. [emphasis added]

Applicant respectfully traverses this rejection on the grounds that, according to MPEP 804, the disclosure of the parent application of the present disclosure, patent 6,658,325, which is both invented by and owned by the inventor of the present disclosure, cannot be used as prior art in an obviousness-type double patenting rejection for this application. Since no additional prior art was cited in section 3, applicant must respectfully conclude that with the exclusion of 6,658,325 as admissible prior art, and nothing else cited, no basis for an obviousness-type double patenting rejection must exist here.

More specifically, applicant respectfully traverses this rejection on the second grounds that according to MPEP 804, the obviousness criteria of 35 U.S.C. 103 must be applied here. These obviousness criteria are set out in MPEP 706.02(j).

MPEP 706.02(j): To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined)

must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143 - 2143.03 for decisions pertinent to each of these criteria.

As discussed in MPEP 706.02(j), in order to establish obviousness, three basic criteria must be met. These are: 1: suggestion or motivation, 2: expectation of success, and 3: teaching of all claim limitations must be found in the prior art.

Since, with the exclusion of 6,658,325, which was invented by the applicant and which is owned by the applicant, no other prior art references have been cited, clearly the MPEP 706.02(j) criteria have not been met. 1: No prior suggestion or motivation has been cited. 2: No citation with which to judge expectation of success has been cited. 3: There is no prior art cited that teaches all of the claim limitations of the present disclosure.

The main goal of any double patenting rejection is to prevent the unjustified or improper timewise extension of the "right to exclude". Applicant respectfully overcomes any further double patenting rejections by agreeing to make allowance of these claims contingent upon applicant's signing a terminal disclaimer. Applicant has filed this terminal disclaimer with this response.

Regarding claims 2, 3, 5, and 6.

These claims were not discussed in the detailed action portion of the office action mailed 3/7/2006. These are dependent claims to independent claims 1 and 4. Since no basis for rejection was given, and since applicant, by being the common owner of patent 6,658,325, has presumably overcome the previous obviousness type double patenting rejection of independent claims 1 and 4, applicant respectfully requests that these claims be allowed.

Regarding claims 8 and 9.

Claims 8 and 9 have never been examined. Applicant's records indicate that claims 8 and 9 were filed with the original September 2, 2003 filing, and in fact were on the same page as claim 7, which was examined. Claim 8 was then subsequently amended in applicant's 12/29/2005 response to the first office action, and Claim 9 was resubmitted with no change. These claims were again on the same page as claim 7, which was examined. Thus claims 8 and 9 have been previously submitted twice before.

Applicant respectfully requests that claims 8-9 be examined. Applicant further respectfully traverses any potential restriction of claims 8 and 9, because they are dependent claims to claim 7, and simply define the same basic invention with greater specificity.

Applicant further respectfully traverses any potential rejection of claims 8-9 on the basis that they are dependent claims to claim 7. As a result, they inherit all of claim 7's limitations. As previously discussed, applicant, by being the common owner of patent 6,658,325, has overcome the previous obviousness type double patenting rejection of claim 7 on the basis of patent 6,658,325.

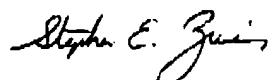
Although applicant now believes that base claims 1, 4 and 7 are now in condition for allowance, applicant respectfully requests that if there are any further objections or rejections to these base claims, that the examiner should provide specific objections or rejections to dependent claims 8 and 9 (as well as dependent claims 2, 3, 5, and 6) and list the statutory basis for such rejections, according to MPEP 2260.01.

2260.01 Dependent Claims: If a base patent claim has been rejected or canceled, any claim which is directly or indirectly dependent thereon should be allowed if it is otherwise allowable. The dependent claim should not be objected to or rejected merely because it depends on a rejected or canceled claim [emphasis added]

In view of the above accompanying remarks and the submission of a terminal disclaimer, applicant believes that the application is now in condition for allowance. Notice to that effect is respectfully requested.

If the examiner believes that a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 348-1495.

Respectfully Submitted



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Inventor